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TROXELL LAW OFFICE PLLC
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER

MARSH, OLIVIA MARIE

ART UNIT PAPER NUMBER

2617

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,310

Applicant(s)

KAO ET AL.

Examiner

Olivia Marsh

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-12, 14-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-12, 14-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 6-7, filed October 2nd, 2006, with respect to the rejection(s) of claim(s) 1-2, 5-7, and 10-11 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Furter *et al* (U.S. 2005/0104732 A1). Please review the below rejection for full explanation.

2. Applicant's arguments filed October 2nd, 2006 have been fully considered but they are not persuasive.

Applicant states "the cited portions [of Himmel] and concluded that neither of the cited portions teaches anything about an adhering material on a surface of an adhering tag" (page 7, paragraph 4). The Examiner respectfully disagrees. Himmel discloses the RFID tag 400 is fabricated on a substrate, which in this example is a clear, flexible film (column 6, lines 59-60). Himmel also discloses the RFID tag is *attached* [emphasis added] to mobile telephone user's 500 mobile telephone (column 7, lines 24-25). The Examiner contends it is inherent the RFID tag 400 must possess an adhering material in order for the flexible film to be attached to the mobile telephone 500. Therefore, the Examiner will maintain the rejection.

3. Applicant's arguments with respect to motivation and combination of Son, Seita, Bashan, Himmel, and Arisawa have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 18-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Himmel et al (U.S. 6,993,319 B2).**

As to claim 18, Himmel discloses:

An apparatus (tag 400) for radio frequency identification (column 6, lines 53-54), comprising:

a supporter (mobile telephone) comprising a shell and a memory chip (non-volatile memory) and an antenna (420), wherein said memory chip and said antenna are adhering tags adhered to said shell wherein said adhering tag is a soft circuit board (flexible film) and is coated with an adhering material on a surface of said adhering tag (column 6, lines 55-65; column 7, lines 19-25).

As to claim 19, Himmel discloses everything as applied in claim 18 and Himmel also discloses:

wherein said supporter is selected from the group consisting of MP3, mobile, and belt (column 7, lines 22-25, choosing "mobile" option).

Art Unit: 2617

As to **claim 21**, Himmel discloses everything as applied in claim 18 and Himmel also discloses:

wherein said antenna comprises a printed circuit board or a coiled enameled wire (Figure 4, choosing option "printed circuit board").

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 5-7, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son (U.S. 2005/0197169 A1) in view of Furter *et al* (U.S. 2005/0104732 A1).**

As to **claim 1**, Son discloses:

an apparatus for radio frequency identification (see paragraphs 3 and 9), comprising:

a supporter comprising a slot (see paragraph 33);

a data card comprising a memory chip, said data card for storing data, said data card receivable into said slot, said data card connected to an antenna (see paragraphs 26, 32-33, and 44). It is inherent the smart card disclosed by Son comprises a memory chip to store data and an antenna to communicate with the SCR.

Son discloses everything as applied in above; however, Son fails to disclose wherein said antenna comprises a coiled enameled wire. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Furter.

In an analogous art, Furter teaches an antenna comprises a coiled enameled wire (paragraphs 1-2, 47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the apparatus and antenna, disclosed by Son, antenna comprises a coiled

Art Unit: 2617

enameled wire, as taught by Furter, to ensure the connection between the RFID device and a reader is optimal (Furter, paragraphs 2, 10, and 12; Son, paragraphs 5-6).

As to **claim 2**, Son and Furter teach everything as applied in claim 1 and Son also discloses supporter is selected from the group consisting of MP3, mobile, watch, and belt (see Figure 1).

As to **claim 5**, Son discloses:

an apparatus for radio frequency identification (see paragraphs 3 and 9), comprising:

a supporter comprising a plurality of slots, said supporter internally connected to an antenna, said antenna for connecting to a memory chip (see Figure 1, paragraphs 9, 26, 30);

a memory chip for storing data, said memory chip being plugged into a slot, said memory chip electronically connected to said antenna by a contact on a surface of said memory chip (see paragraphs 30, 31, 35).

Son discloses everything as applied in above; however, Son fails to disclose wherein said antenna comprises a coiled enameled wire. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Furter.

Furter also teaches an antenna comprises a coiled enameled wire (paragraphs 1-2, 47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the apparatus and antenna, disclosed by Son, antenna comprises a coiled enameled wire, as taught by Furter, to ensure the connection between the RFID device and a reader is optimal (Furter, paragraphs 2, 10, and 12; Son, paragraphs 5-6).

As to **claim 6**, Son and Furter teach everything as applied in claim 5 and Son also discloses a second slot for directly connecting to a data card having an antenna (see Figure 1, paragraphs 26, 32-33, and 44).

Art Unit: 2617

As to **claim 7**, Son and Furter teach everything as applied in claim 5 and Son also discloses supporter is selected from the group consisting of MP3, mobile, watch, and belt (see Figure 1).

As to **claim 10**, Son discloses:

a method and apparatus for radio frequency identification (see paragraphs 3 and 9), comprising:

a supporter comprising a memory chip, said memory chip for storing data, said supporter comprising an antenna which is to obtain induced voltage (see Figure 1, paragraphs 9, 26, 32-33, and 44). It is inherent the smart card disclosed by Son comprises a memory chip to store data and an antenna that induces voltage to communicate with the SCR.

Son discloses everything as applied in above; however, Son fails to disclose wherein said antenna comprises a coiled enameled wire. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Furter.

Furter also teaches an antenna comprises a coiled enameled wire (paragraphs 1-2, 47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the apparatus and antenna, disclosed by Son, antenna comprises a coiled enameled wire, as taught by Furter, to ensure the connection between the RFID device and a reader is optimal (Furter, paragraphs 2, 10, and 12; Son, paragraphs 5-6).

As to **claim 11**, Son and Furter teach everything as applied in claim 10 and Son also discloses supporter is selected from the group consisting of MP3, mobile, watch, and belt (see Figure 1).

Art Unit: 2617

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seita (U.S. 6973327 B2) in view of Furter et al (U.S. 2005/0104732 A1).

As to **claim 14**, Seita discloses:

an apparatus for radio frequency identification (see column 1, lines 17-20, column 1, lines 44-46), comprising:

a supporter comprising a shell, wherein a memory chip and an antenna are inside said shell (column 3, lines 65-67, column 5, lines 5-10, column 5, lines 19-23; Figures 3A-3B).

Seita discloses everything as applied above; however, Seita fails to disclose wherein said antenna comprises a coiled enameled wire. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Furter.

Furter also teaches an antenna comprises a coiled enameled wire (paragraphs 1-2, 47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the apparatus and antenna, disclosed by Seita, antenna comprises a coiled enameled wire, as taught by Furter, to ensure the RFID antenna's transponding capabilities is optimal (Furter paragraphs 2 and 12; Seita column 4, lines 9-10).

As to **claim 15**, Seita and Furter teach everything as applied in claim 14 and Seita also discloses supporter is selected from the group consisting of MP3, mobile, watch, and belt (column 1, lines 17-20).

Art Unit: 2617

6. Claims 3, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son and Furter as applied to claims 1, 5, and 10 above, and further in view of Arisawa et al (U.S. 2003/0141989 A1).

As to **claim 3**, Son and Furter teach everything as applied in claim 1; however, neither Son nor Furter teaches the memory chip comprises a plurality of components of diode and capacitor. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Arisawa.

In the same field of endeavor, Arisawa teaches a memory chip comprises a plurality of components of diode and capacitor (see Figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the memory chip and data card, taught by Son and Furter, memory chip comprises a plurality of components of diode and capacitor, as taught by Arisawa, to enable financial transactions via a contactless ID chip (Arisawa, paragraph 14; Son, paragraph 6).

As to **claim 8**, Son and Furter teach everything as applied in claim 5; however, neither Son nor Furter teach the memory chip comprises a plurality of components of diode and capacitor. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Arisawa.

Arisawa teaches a memory chip comprises a plurality of components of diode and capacitor (see Figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the memory chip and data card, taught by Son and Furter, memory chip comprises a plurality of components of diode and capacitor, as taught by Arisawa, to enable financial transactions via a contactless ID chip (Arisawa, paragraph 14; Son, paragraph 6).

Art Unit: 2617

As to **claim 12**, Son and Furter teach everything as applied in claim 10; however, neither Son nor Furter teach the memory chip comprises a plurality of components of diode and capacitor. The Examiner maintains this feature was old and well known in the art at the time of invention as taught by Arisawa.

Arisawa teaches a memory chip comprises a plurality of components of diode and capacitor (see Figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the memory chip and data card, , taught by Son and Furter, memory chip comprises a plurality of components of diode and capacitor, as taught by Arisawa, to enable financial transactions via a contactless ID chip (Arisawa, paragraph 14; Son, paragraph 6).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seita and Furter as applied to claim 14 above, and further in view of Arisawa et al (U.S. 2003/0141989 A1).

As to **claim 16**, Seita and Bashan teach everything as applied in claim 14; however, neither Seita nor Bashan teaches the memory chip comprises a plurality of components of diode and capacitor. The Examiner contends this feature was old and well known in the art at the time of invention as taught by Arisawa.

Arisawa teaches a memory chip comprises a plurality of components of diode and capacitor (see Figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the memory chip and data card, taught by Seita and Furter, memory chip comprises a plurality of components of diode and capacitor, as taught by Arisawa, to enable financial transactions via a contactless ID chip (Arisawa, paragraph 14; Son, paragraph 6).

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel as applied to claim 18 above, and further in view of Arisawa *et al* (U.S. 2003/0141989 A1).

As to **claim 20**, Himmel discloses everything as applied in claim 18; however, Himmel fails to disclose the memory chip comprises a plurality of components of diode and capacitor. The Examiner contends this feature was old and well known in the art at the time of invention as taught by Arisawa.

Arisawa teaches a memory chip comprises a plurality of components of diode and capacitor (see Figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the memory chip and data card, disclosed by Himmel, the memory chip comprises a plurality of components of diode and capacitor, as taught by Arisawa, to enable financial transactions via a contactless ID chip (Arisawa, paragraph 14; Himmel, column 1, lines 38-41).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olivia Marsh whose telephone number is 571-272-7912. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


CHARLES APPIAH
PRIMARY EXAMINER